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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
COUGHLAN, PETER D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/697,433	AREND, THOMAS	
	Examiner	Art Unit	
	Peter Coughlan	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/20/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

1. This office action is in response to an AMENDMENT entered August 20, 2007 for the patent application 10/697433 filed on 10/31/2004

2. All previous Office Actions are fully incorporated into this Final Office Action by reference.

Status of Claims

3. Claims 1-14 are pending.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 7, 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the

time the application was filed, had possession of the claimed invention.. These claims contain the 'sets', which are semantically grouped solution identification rules.' There is no indication, method or algorithm described within the specification how the invention groups these 'identification rules' bases on semantics. Paragraph 0057 states that solution identification rules are grouped together if they are 'semantically related' but fails to describe how this is accomplished.

These claims need to be amended or withdrawn from consideration.

Claims 6, 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This claim has the additional 'returns solutions that solve the problem indirectly by being further knowledge representations for further inference module' but the specification is silent explaining how this is accomplished. There is no explanation how the invention solves problems indirectly.

These claims need to be amended or withdrawn from consideration.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This claim states 'that analysis by an expert system in the further computer.' The phrase 'expert system is mentioned within paragraphs 0032, 0075, 0096, 0149, 0160 but what type of expert system is not mentioned. There needs to be a specific 'expert system' disclosed due to the fact there are numerous types with specific advantages to each one.

This claim needs to be amended or withdrawn from consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 12 are rejected under 35 U.S.C. 102(b) (hereinafter referred to as **Wookey**) being anticipated by Wookey et al., U.S. 6237114.

Claim 1.

Wookey teaches a main computer system comprising a database, an application server and a front-end server, wherein the main system executes an application in cooperation with a human user (**Wookey,** Fig. 1A and 1B, C3:39

through C4:4; 'Main computer system' of applicant is equivalent to 'monitored computer system' of Wookey. 'Database' of applicant is inherent by all the databases within all the computers being monitored within the main computer system (item 102). 'Application server' of applicant is disclosed by 'tests' of Wookey. 'Front end server' of applicant is equivalent to 'communication' of Wookey.), and a remote service computer system for evaluating problems in the main system (**Wookey,** Fig. 1A and 1B, C3:39 through C4:4; 'Remote service computer system' of applicant is equivalent to 'exemplary computer system' (item 100) of Wookey.) comprising: a service module, to collect problem related data from the main system said problem related data representing a problem identified about data in the main system (**Wookey,** Fig. 13, C17:61 through C18:29; 'Service module' which collects 'problem related data' of applicant is equivalent to 'run alerts against incoming host state' (item 1301) of Wookey.) an acquisition module to acquire knowledge representations (**Wookey,** Fig. 13, C17:61 through C18:29; 'Acquisition module' of applicant is disclosed by the search for 'keywords' of known problems of Wookey.) a knowledge module, to store the knowledge representations and store the knowledge representations with sets of semantically grouped solution identification rules (**Wookey,** Fig. 13, C17:61 through C18:29; 'Knowledge module' of applicant is equivalent to 'system resolution database' of Wookey.), and an inference module to process problem related data with knowledge representations to identify solutions, and forward, the solutions through the service module to the main computer system (**Wookey,** Fig. 13, C17:61 through C18:29; 'Inference module' of applicant is illustrated by

the 'resolutions in step 1305' of Wookey.), wherein the inference module identifies the solutions by applying knowledge representations in at least one of a sequential order, a hierarchical order, and a dynamically adaptive order and (**Wookey,** C2:19-33; 'Hierarchical order' of applicant is disclosed by the 'hierarchical representation' of Wookey.) , wherein the identified solutions are applied to solve the problem identified in the main system. (**Wookey,** abstract, C16:21-33; The solutions are presented to a support engineer to diagnosing a problem or the problem can be solved automatically by a daemon process.)

Claim 2.

Wookey teaches the main system and the service system communicate through remote function call connections provided by the service module. (**Wookey,** Fig. 1A and 1B, C3:39 through C4:4, C5:10-24; The communication between the 'exemplary computer system' and the 'monitored computer system' is accomplished by the 'modem pool' (item 101) and the modem (item 114). Connectivity and related 'function call connections' between these two items is equivalent to 'direct modem link' of Wookey.)

Claim 3.

Wookey teaches wherein the service module monitors the application server and the database according to instructions from the inference module. (**Wookey,** Fig. 13, C17:61 through C18:29; 'Service module' which collects 'problem related data' of applicant is equivalent to 'run alerts against incoming

host state' (item 1301) of Wookey. In this fashion, checking 'run alerts against incoming host state' is equivalent to 'monitors.')

Claim 4

Wookey teaches wherein the main system and the service system are systems in client/server configuration. (**Wookey,** Fig. 1A. 1B, C3:39-51; The main computer systems 100 and 102 are linked via a modem. Computers 104, 106, 108 and 110 are computers and not terminals thus splitting the computation between the two devices.)

Claim 5.

Wookey teaches wherein the service system returns solutions that solve the problem directly in the main system. (**Wookey,** abstract, C16:21-33; The ability to solve the problem directly can be solved automatically by a daemon process.)

Claim 6.

Wookey teaches wherein the service system returns solutions that solve the problem indirectly by being further knowledge representations for a further inference module operating for the main system. (**Wookey,** abstract, C16:21-33; Solving problems indirectly by using knowledge representations of applicant is equivalent to using a 'support engineer' of Wookey.)

Claim 7.

Wookey teaches collecting problem related data from the main system by a service module of a remote service system (**Wookey,** 'Collecting problem data' of applicant is first obtained by running 'alerts against incoming host state' in Wookey. If there is a 'severe alert' then the information collected can be viewed as equivalent to 'collecting problem related data' of applicant.) said problem related data representing a problem identified about data in the main system (**Wookey,** Fig. 1A and 1B, C3:39 through C4:4; 'Main computer system' of applicant is equivalent to 'monitored computer system' of Wookey.) acquiring knowledge representations by an acquisition module of the service system (**Wookey,** Fig. 13, C17:61 through C18:29; 'Acquisition module' of applicant is disclosed by the search for 'keywords' of known problems of Wookey.), receiving the knowledge representations by a knowledge module (**Wookey,** Fig. 13, C17:61 through C18:29; 'Knowledge module' of applicant is equivalent to 'system resolution database' of Wookey.); storing the knowledge representations with sets of semantically grouped solution identification rules by the knowledge module of the service system (**Wookey,** Fig.1A, 1B, C2:19-33; Wookey looks for keywords in the acquisition module. Information concerning the diagnostic information is hierarchical represented. Therefore knowledge representations would be semantically grouped.); processing problem related data with the knowledge representations by a inference module to identify solutions wherein the inference module identifies the solutions by applying knowledge representations in at least one of a sequential order, a hierarchical, and a dynamically adaptive order (**Wookey,** C2:19-33; 'Hierarchical order' of applicant

is disclosed by the 'hierarchical representation' of Wookey.); forwarding the solutions through the service module to the main system (**Wookey,** Fig. 1A and 1B; 'Forwarding the solutions' of applicant is accomplished by the two figures with the 'modem pool (item 101) in figure 1A being connected to modem (item 114) in figure 1B of Wookey.); and applying the identified solutions to solve the problem identified in the main system by changing the state of memory in the main system. (**Wookey,** abstract, C16:21-33; 'Applying the identified solutions' can be accomplished by using a 'support engineer' or by a daemon process of Wookey.)

Claim 12.

Wookey teaches evaluating problems in a main computer system that executes an application (**Wookey,** Fig. 13, C17:61 through C18:29; 'Service module' which collects 'problem related data' of applicant is equivalent to 'run alerts against incoming host state' (item 1301) of Wookey.), wherein: the inference module processes problem related data with knowledge representations to identify solutions, said knowledge representations being stored with sets of semantically grouped solution identification rules (**Wookey,** Fig. 13, C17:61 through C18:29; 'Inference module' of applicant is illustrated by the 'resolutions in step 1305' of Wookey.), and the inference module characterized in that the inference module is part of a service system receiving problem related data from the main computer system over a network, said problem related data representing a problem identified about data in the main

system (**Wookey,** Fig. 1A and 1B; 'Over a network' of applicant is illustrated in the two figures with the 'modem pool (item 101) in figure 1A being connected to modem (item 114) in figure 1B of Wookey.); and returning solutions to the main system, wherein a first case, the service system returns solutions that solve the problem directly and, in a second case, the service system returns solutions that solve the problem indirectly by being further knowledge representations for a further inference module, (**Wookey,** abstract, C16:21-33; Solving problems indirectly by using knowledge representations of applicant is equivalent to using a 'support engineer' of Wookey. The ability to solve the problem directly can be solved automatically by a daemon process.) further wherein during the processing of problems related data, the inference module identifies the solutions by applying knowledge representations in at least one of a sequential order, a hierarchical order, and a dynamically adaptive order. (**Wookey,** C2:19-33; 'Hierarchical order' of applicant is disclosed by the 'hierarchical representation' of Wookey.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the

> prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wookey as set forth above, in view of Richards and further in view of Carberry. (U. S. Patent Publication 20020147850, referred to as **Richards**; U. S. Patent Publication 20020156629, referred to as **Carberry**)

Claim 8.

Wookey does not teach identifying the solutions form set of predefined advices of the application, communicate questions to the user by composing the questions from predefined passages provided by the application, and analyses responses that the user enters in natural language.

Richards teaches identifying the solutions form set of predefined advices of the application, communicate questions to the user by composing the questions from predefined passages provided by the application. (**Richards,** ¶0030; 'Identifying the solutions form set of predefined advices' of applicant is equivalent to 'provide intelligent navigation to the appropriate diagnostic steps' of Richards. 'Communicate questions to the user' of applicant is equivalent to 'potential answers to an initial question automatically direct the user to one or more follow-up or related questions' of Richards.)

Carberry teaches analyses responses that the user enters in natural language. (**Carberry,** ¶0010)

It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Wookey by an interactive dialog between the invention and a user with Multilanguage abilities as taught by Richards and Carberry to identify the solutions form set of predefined advices of the application, communicate questions to the user by composing the questions from predefined passages provided by the application, and analyses responses that the user enters in natural language.

For the purpose of using natural language for ease of inputting data and not being limited to a specific language.

Claim 9.

Wookey teaches the service system forwards problem data and solutions for further analysis by a human technician. (**Wookey,** abstract, C16:21-33; Solving problems indirectly by using knowledge representations of applicant is equivalent to using a 'support engineer' of Wookey.)

Claim 10.

Wookey teaches the service system forwards problem data and solutions to the further computer in a format that allows analysis by an expert system in the further computer. (**Wookey,** C15:54 through C16:5; 'Forwards problem data and solutions ... in a format' of applicant is disclosed by using 'graphic user interface' to display information to the 'engineer' of Wookey.)

Claim 11.

Wookey teaches program code means for performing all the steps of anyone of the claims 7-10 when the computer program product is run on a computer. (**Wookey,** abstract; 'Computer product code is run on a computer' is disclosed by a 'computer system used in monitoring another computer system' can only occur if 'computer product code is run on a computer.')

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wookey as set forth above, in view of Fujinaga. (U. S. Patent Publication 20010056379, referred to as **Fujinaga**)

Claim 13.

Wookey does not teach the main system executes an enterprise resource planning application.

Fujinaga teaches the main system executes an enterprise resource planning application. (**Fujinaga,** ¶0014 and ¶0109) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Wookey by identifying computer problems and attributes as taught by Fujinaga to have the main system executes an enterprise resource planning application.

For the purpose of using the system to operate within all fields of an enterprise.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wookey as set forth above, in view of Adendorff. (U. S. Patent Publication 20020099563, referred to as **Adendorff**)

Claim 14.

Wookey does not teach wherein the main system is implemented as an R/3 system.

Adendorff teaches wherein the main system is implemented as an R/3 system. (**Adendorff,** ¶0175 and ¶0177) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Wookey by having an invention which can work with the R/3 system as taught by Adendorff to have wherein the main system is implemented as an R/3 system.

For the purpose of having an invention which works with an established product such as R/3 for ease of implementation.

Response to Arguments

5. Applicant's arguments filed on August 20, 2007for claims 1-14 have been fully considered but are not persuasive.

6. In reference to the Applicant's argument:

REMARKS

By the present amendment, Applicant has amended independent claims 1, 7, and 12. Claims 1-14 remain pending.

In the June 21, 2007 Office Action1, the Examiner rejected claims 1, 6, 7, 10, and 12 under 35 U.S.C § 112, first paragraph as failing to comply with the written description requirement; rejected claims 1-14 under 35 U.S.C § 101 as being directed to non-statutory subject matter; rejected claims 1-7, 11, and 12 under 35 U.S.C § 102(b) as being anticipated by "Semantic Mediation for Cooperative Spatial Information Systems: The AMUN Data Model," to Leclercq et al. ("Leclercq"); rejected claims 9 and 10 under 35 U.S.C § 103(a) as being unpatentable over Leclercq in view of U.S. Patent No. 5,960,200 to Eager et al. ("Eager"); and rejected claims 8, 13, and 14 under 35 U.S.C § 103(a) as being unpatentable over Leclercq in view of U.S. Published Patent Application No. 2002/0099563 to Adendorff et al. ("Adendorff'). Applicant traverses each of the Examiner's rejections. In addition, Applicant would like to thank the Examiner for the August 2, 2007 interview with Applicant's representative, and note that no agreement was reached.

I.

Rejection of Claims 1, 6, 7, and 12 under 35 U.S.C § 112, first paragraph

Applicant respectfully traverses the rejection of claims 1,6, 7, 10, and 12 under 35 U.S.C § 112, first paragraph for allegedly failing to comply with the written description requirement by "contain[ing] subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." (Office Action, page 2, ¶ 4).

Applicant notes that "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention," (MPEP § 2163, emphasis added). Furthermore, "[i]t is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification." Id.

The Examiner first alleged that the phrase "semantically grouped solution identification rules" as recited in claims 1, 7, and 12, fails to comply with the written description requirement. However, examples of this feature are clearly provided in Applicant's disclosure, such as, for example, in ¶ [052] of the specification.

Examiner's response:

'Semantics' is the study of meanings. The rejection is how does the

invention accomplish generating a set one specific (group A) semantically

grouped solution identification rules from another specific (group B) semantically grouped solution identification rules? How is this done? Is there some formula, method or algorithm which separates 'semantically grouped solution identification rules' into one group or another. The specification is silent on how this is accomplished. The fact it is mentioned does not explain how this is achieved. Office Action stands.

7. In reference to the Applicant's argument:

The Examiner next alleged that the phrase "a sequential order, a hierarchical order, and a dynamically adaptive order" as recited in claims 1, 7, and 12, fails to comply with the written description requirement. However, these features were disclosed in Applicant's original claim 8 and, therefore, were part of the original disclosure. "There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, Wertheim, 541 F.2d at 262, 191 USPQ at 96." Id. Applicant further notes that the Examiner did not raise the rejection when originally examining claim 8. Finally, examples of these features are provided in applicant's disclosure, for example, at ¶¶ [053]-[057] of the specification, as well as Figure 6.

Examiner's response:

The Examiner considered the applicant's arguments and withdraws the rejection.

8. In reference to the Applicant's argument:

The Examiner next alleges that the phrase, "wherein the service system returns solutions that solve the problem indirectly by being further knowledge representations for a further inference module operating for the main system," recited in claims 6 and 12, fails to comply with the written description

requirement because "[t]here is no explanation how the invention solves a problem indirectly." (Office Action, page 4). However, both the claim language and ¶ [0100] of Applicant's specification recite that this is done "by being further knowledge representations for a further inference module operating for the main system,"

Examiner's response:

The rejection questions the meaning 'solve the problem indirectly by being further knowledge representations for a further inference module' which pertains to indirectly solving problems. The claim language parallels the specification language but there lacks detail, explanation or outline of steps concerning what is actually occurring by the statement 'solve the problem indirectly by being further knowledge representations for a further inference module.' Office Action stands.

9. In reference to the Applicant's argument:

The Examiner last alleges that the phrase "allows analysis by an expert system in the further computer," recited in claim 10, fails to comply with the written description requirement. The Examiner argues that "[t]here needs to be a specific 'expert system' disclosed due to the fact there is are numerous types with specific advantages to each one," (Office Action, page 4). Applicant disagrees, and note that there is no such requirement in 35 U.S.C § 112, first paragraph.

Therefore, Applicant submits that in view of the specification, one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Accordingly, the Examiner should withdraw the rejection of claims 1,6, 7, 10, and 12 under 35 U.S.C § 112, first paragraph.

Examiner's response:

There are numerous 'expert systems' which can be employed in the invention. The specification does not mention what type of expert system is to be

employed, if fact the specification does not even give a listing of potential 'expert systems' which can be employed within the invention. The specification can view any method which has the ability to divide, categorize or separate as an 'expert system' without merit. Office Action stands.

10. In reference to the Applicant's argument:

II. Rejection of Claims 1-14 under 35 U.S.C § 101
Applicant respectfully traverses the rejection of claims 1-14 under 35 U.S.C § 101 for being directed to non-statutory subject matter. The Examiner alleges that the claimed invention is not limited to a substantial practical application and does not produce a real world result (Office action, page 5).

Although Applicant respectively disagrees, in order to expedite prosecution, Applicant has amended independent claim 1 to recite "a main computer system" and "a remote service computer system," as elements of the system. Applicant submits that these two elements, along with the claimed functionality, constitutes a real world result and substantial practical application. Applicant has also amended independent claim 7 to recite, "applying the identified solutions to solve the problem identified in the main system by changing the state of memory in the main system." Applicant submits that this also constitutes a real world result and substantial practical application. Accordingly, the Examiner should withdraw the rejection of claims 1-14 under 35 U.S.C § IOI.

Examiner's response:

Due to a current shift in Office policy concerning 35 U.S.C. §101, the Examiner is now allowed to search the specification for a practical application. The Examiner was able to find a practical application within the specification and withdraws the rejection under 35 U.S.C. §101.

11. In reference to the Applicant's argument:

III.
Rejection of Claims 1-7, 11, and 12 under 35 U.S.C § 102(b)
Applicant respectfully traverses the rejection of claims 1-7, 11, and 12 under 35 U.S.C § 102(b) as being anticipated by Leclercq. In order to properly establish anticipation under 35 U.S.C. § 102, the Court of Appeals for the Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). See also M.P.E.P. § 2131. Here, Leclercq does not teach or suggest each and every element of the claims.

For example, Leclercq fails to teach or suggest at least, "a remote service computer system for evaluating problems in the main system, comprising," inter alia, "an inference module to process problem related data with knowledge representations to identify solutions and forward the solutions through the service module to the main computer system," as recited by independent claim 1.

Instead, Leclercq appears to be generally directed to "designing interoperable systems in which collections of autonomous and heterogeneous information systems [i.e. global information systems (GIS)] can cooperate to carry out tasks," (Leclercq, § 1, ¶ 1, lines 2-4; and Abstract). Furthermore, Leclercq purports to "address several key issues regarding how contexts can be represented and used to capture semantics of concepts of different sources, and how semantic similarities between objects can be detected and used to reconcile discrepancies" (Introduction, ¶ 3, lines 15-19). The Examiner appears to allege that these discrepancies between data from different GIS sources, and the access of semantically different data from one GIS to another, constitutes the claimed "problem related data," (Office Action, page 8). However, this is incorrect because Leclercq's GIS data is not "problem related data representinq a problem identified about data in the main system," as recited by claim 1 (emphasis added). The GIS data is not "representing" an incompatibility [alleged "problem"] as claimed. Instead, it is only data related to its GIS.

Furthermore, Leclercq discloses an ISIS mediation approach, "which may help some of the requirements of GIS interoperability," (Leclercq, § 3, ¶ 1, lines 2-3). This is accomplished first by a wrapper level, "whose main task is to facilitate external accesses," and second by a cooperation level "which provides services and functionalities to facilitate semantic resolution and query processing,"

(Leclercq, § 3, ¶ 2-3). The Examiner appears to allege that Leclercq's wrapper level and cooperation level of a GIS that receives data constitutes the claimed "knowledge representations," as recited by claim 1 (Office Action, page 8). The Examiner further appears to allege that a sending GIS (alleged "main computer system"), sends incompatible data (alleged "problem") to a receiving GIS (alleged "remote service computer"), and that the receiving GIS ensures data compatibility using wrapper and cooperation levels (alleged "knowledge representations").

However, this is incorrect at least because the receiving GIS does not "identify solutions and forward the solutions through the service module to the main computer system," as required by independent claim 1 (emphasis added). In fact, Leclercq provides no "solutions" to the "problem" of data incompatibility as claimed, and the receiving GIS does not "forward" anything back to the sending GIS. Instead, Leclercq reconciles the differences so that one GIS can read the data of a second GIS. Accordingly, and for at least these reasons, Leclercq fails to teach or suggest each and every element of independent claim 1, and the rejection of claim 1 under 35 U.S.C § 102(b) should be withdrawn.

Independent claims 7 and 12, while differing in scope, comprises elements similar to those noted above with respect to independent claim 1. Accordingly, the Examiner should withdraw the rejection of claims 7 and 12 under 35 U.S.C § 102(b) for at least the reasons discussed previously.

Examiner's response:

Leclercq is no longer used as a reference due to the amendments made. Wookey is used as a primary reference. 'Main computer system' of applicant is equivalent to 'monitored computer system' of Wookey. 'Database' of applicant is inherent by all the databases within all the computers being monitored within the main computer system (item 102). 'Application server' of applicant is disclosed by 'tests' of Wookey. 'Front end server' of applicant is equivalent to 'communication' of Wookey. (**Wookey,** Fig. 1A and 1B, C3:39 through C4:4) 'Remote service computer system' of applicant is equivalent to 'exemplary computer system' (item 100) of Wookey. (**Wookey,** Fig. 1A and 1B, C3:39 through C4:4) 'Service

module' which collects 'problem related data' of applicant is equivalent to 'run alerts against incoming host state' (item 1301) of Wookey. (**Wookey,** Fig. 13, C17:61 through C18:29) 'Acquisition module' of applicant is disclosed by the search for 'keywords' of known problems of Wookey. (**Wookey,** Fig. 13, C17:61 through C18:29) 'Knowledge module' of applicant is equivalent to 'system resolution database' of Wookey. (**Wookey,** Fig. 13, C17:61 through C18:29) 'Inference module' of applicant is illustrated by the 'resolutions in step 1305' of Wookey. (**Wookey,** Fig. 13, C17:61 through C18:29) 'Hierarchical order' of applicant is disclosed by the 'hierarchical representation' of Wookey. (**Wookey,** C2:19-33) The solutions are presented to a support engineer to diagnosing a problem or the problem can be solved automatically by a daemon process. (**Wookey,** abstract, C16:21-33) Office Action stands.

12. In reference to the Applicant's argument:

Claims 2-6, and 11 depend from independent claims 1 or 7 and, therefore, require all elements thereof. Accordingly the Examiner should withdraw the rejection of claims 2-6, and 11 under 35 U.S.C § 102(b) at least due to this dependence.

Examiner's response:

The arguments regarding claims 1 and 7 are rejected therefore applicants arguments concerning claims 2-6 and 11 are moot. Office Action stands.

13. In reference to the Applicant's argument:

IV.
Rejection of Claims 9 and 10 under 35 U.S.C § 103(a)
Applicant respectfully traverses the rejection of claims 9 and 10 under 35 U.S.C § 103(a) as being unpatentable over Leclercq in view of Eager because no prima facie case of obviousness has been established. To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2. Here, no prima facie case of obviousness has been established at least because the cited references fail to teach or suggest each and every element of the claims.

Claims 9 and 10 depend from independent claim 7 and, therefore, require all elements thereof. As discussed previously, Leclercq fails to teach or suggest each and every element of independent claim 7.

Eager does not cure the deficiencies of Leclercq. That is, Eager fails to teach or suggest at least "a remote service computer system for evaluating problems in the main system, comprising," inter alia, "an inference module to process problem related data with knowledge representations to identify solutions and forward the solutions through the service module to the main computer system," as recited by independent claim 1. Therefore, Leclercq and Eager, whether taken alone or in combination, fail to establish a prima facie case of obviousness with respect to claims 9 and 10 at least to their dependence. Accordingly, the Examiner should withdraw the rejection of claims 9 and 10 under 35 U.S.C § 103(a).

Examiner's response:

Claims 9 and 10 are also rejected under Wookey. Solving problems indirectly by using knowledge representations of applicant is equivalent to using a 'support engineer' of Wookey. (**Wookey,** abstract, C16:21-33) 'Forwards problem data and solutions ... in a format' of applicant is disclosed by using

'graphic user interface' to display information to the 'engineer' of Wookey.

(**Wookey,** C15:54 through C16:5) Office Action stands.

14. In reference to the Applicant's argument:

V.
Rejection of Claims 8, 13, and 14 under 35 U.S.C § 103(a)
Claims 8, 13, and 14 depend from independent claims 1 or 7 and, therefore, require all elements thereof. As discussed previously, Leclercq fails to teach or suggest each and every element of independent claims 1 and 7.

Adendorff does not cure the deficiencies of Leclercq. That is, Adendorff fails to teach or suggest at least "a remote service computer system for evaluating problems in the main system, comprising," inter alia, "an inference module to process problem related data with knowledge representations to identify solutions and forward the solutions through the service module to the main computer system," as recited by independent claim 1. Therefore, Leclercq and Adendorff, whether taken alone or in combination, fail to establish a prima facie case of obviousness with respect to claims 8, 13, and 14 at least due to their dependence. Accordingly, the Examiner should withdraw the rejection of claims 8, 13, and 14 under 35 U.S.C § 103(a).

Examiner's response:

Adendorff is now only used with claim 14. Claim 14 states the main system is a R/3 system. Adendorff discloses systems that can be R/3 systems.

Office Action stands.

Examination Considerations

15. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, l 45-48; p 2100-9, c 1, l 1-4). The Examiner has the full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

16. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and sprit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but link to prior art that one of ordinary skill in the art would find inherently appropriate.

17. Examiner's Opinion: Paragraphs 15 and 16 apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Claims 1-14 are rejected.

Correspondence Information

20. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner Peter Coughlan, whose telephone number is (571) 272-5990. The Examiner can be reached on Monday through Friday from 7:15 a.m. to 3:45 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor David Vincent can be reached at (571) 272-3080. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

Hand delivered to:

Receptionist,

Customer Service Window,

Randolph Building,

401 Dulany Street,

Alexandria, Virginia 22313,

(located on the first floor of the south side of the Randolph Building);

or faxed to:

(571) 272-3150 (for formal communications intended for entry.)

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Peter Coughlan

10/5/2007

JOSEPH P HIRL
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100